

REMARKS/ARGUMENTS

The present communication is responsive to the Official Action mailed on October 8, 2003.

Claims 1-19 remain pending in the application. Of the pending claims, claims 1, 6, 11, and 16 are independent claims. All the other pending claims depend from one of the independent claims.

Paragraph [0023] has been amended to correct a minor typographical error. In particular, the reference to address "IF" has been changed to --1F-- as is shown in Fig. 3. Applicant respectfully submits that this amendment to the specification does not constitute the addition of new matter as "1F" is clearly shown in Fig. 3.

Claim 1 has been amended to now recite "controlling, by the main unit, execution of the requested function based upon at least the code of the function read from the read area." Applicant respectfully submits that this amendment to claim 1 does not constitute the addition of new matter. More particularly, antecedent basis for this amendment may be found, for example, by reference to paragraph [0032].

Claim 2 has been amended to improve its form. In particular, applicant deleted the phrase "and a code associated therewith" from claim 2.

Claim 3 has also been amended to improve its form. As such, claim 3 now recites "A control method according to claim 2, further comprising accessing the predetermined address by the main unit to determine the function to be executed."

Applicant has amended claim 6 to now recite "a read area in which a code of a function selected in the electronic device is read and detected by the main unit to enable changing of the requested function by the main unit." Antecedent basis for this amendment may be found, for example, by reference to

paragraph [0022]. Applicant therefore respectfully submits that this amendment does not constitute the addition of new matter.

Claim 7 has been amended to improve its form and now recites "An electronic device according to claim 6, further including a memory, the memory including at a pre-determined location a list of the codes of the function to be executed."

Claims 8 and 9 are cancelled.

Claim 10 has been amended to now recite "An electronic device according to claim 6, wherein the electronic device is adapted to enable execution of the function requested by the main unit based on a determination made by a main unit." Applicant respectfully submits that the amendments to claim 10 are to improve its form.

Claim 11 has been amended to now recite "a read area in which a code of a function selected in the electronic device is read and detected by the main unit to enable updating of the requested function by the main unit." Antecedent basis for this amendment may be found, for example, by reference to paragraph [0032]. Applicant therefore respectfully submits that this amendment does not constitute the addition of new matter.

Claim 14 has been amended to improve its form and now recites "the system according to claim 11, wherein the main unit is adapted to determine the function to be executed by writing the code of an arbitrary function in the write area, and by reading the code of a function selected in the electronic device from the read area."

Claim 16 has been amended to now recite "wherein the menu is adapted to write a code of a function requested by the main unit in write area, to read a code of a function to be executed from the read area and to control execution of the requested function in the electronic device based on the read code." Proper antecedents for this amendment may be found, for example, by reference to paragraph [0029].

Claim 17 has been amended to improve its form and now recites "The main unit according to claim 16, wherein the electronic device has a memory, the memory including at a predetermined address a list of codes of the functions to be executed and codes associated therewith, and wherein the main unit is adapted to determine the function to be executed by accessing the predetermined address."

Applicant respectfully submits that the amendments to claims 1, 6, 11, and 16 more clearly recite that which applicant regards as the claimed invention. In addition, applicant respectfully submits that the amendments to the claims place the application in proper form for appeal.

In the Official Action the Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,901,303 to *Chew* (hereinafter "*Chew*").

Regarding claims 1, 6, 11, and 16, the Examiner asserts that *Chew* teaches providing a removably connected electronic device, e.g., a smart card, that includes a register (memory) having a write area and read area, citing to Fig. 1 and column 4, lines 53-64 of *Chew*. The Examiner further asserts that *Chew* discloses that the smart card performs start-up processes and "then receives a command from the main unit (reader, column 6, lines 14-21)." (Official Action at 2-3.) The Examiner further asserts "It is inherent to *Chew* that the requested function is written into the write area of the register (RAM) when the command is processed (col. 6, lns. 19-21). *Chew* then teaches the reading of a code of a function (col. 6, lns. 19-21 and 26-27, and col. 4, lns. 63, through col. 5, ln. 5), and a code associated therewith (col. 5, lns. 5-12). *Chew* also teaches detection of a requested function by the main reader unit (col. 4, lns. 19-25)." (*Id.* at 3.)

Applicant respectfully traverses the Examiner's rejection. The Examiner's assertion that *Chew* inherently

teaches "that the requested function is written into the write area of the register (RAM) when the command is processed" is incorrect. In supporting his assertion, the Examiner cites to a sentence at column 6, lns. 19-21 of *Chew*, which states: "When a response is received, the operating system parses the commands and checks in its function look-up table to see if it is a valid command." *Chew* makes clear, in the sentence immediately preceding the quoted sentence "the operating system waits for a command from the reader." (*Chew*, col. 6, lns. 16-19.) Furthermore, "the operating system" is the "smart card operating system." (*Id.*, lns. 11-14.) Thus, properly interpreted, the portion of *Chew* relied on by the Examiner (i.e., col. 6, lns. 19-21) states that the memory card receives a command from the reader unit, parses the received command and checks its (i.e., the memory card's) function tables to determine the validity of the received command. Thus, the reader unit does not request any action by the memory card. In fact, what is inherent is that the memory card requests a function from the reader unit. This is completely opposite to the Examiner's assertion and to what is recited in the claims. In particular, claim 1 recites "writing a code of a function requested by the main unit in the write area of the register." That is, claim 1 requires that the code of the function written into the write area be "requested by the main unit." In *Chew*, however, it's the memory card or electronic device that requests and controls the writing operation. *Chew* explicitly teaches opposite to claim 1 and therefore applicant respectfully submits that it is entirely unreasonable for the Examiner to draw the completely opposite inference to that which is recited in claim 1 (and all the claims).

Further in this regard, claims 6 and 11 specifically recite "the register including a write area in which the code of a function requested by the main unit is written." Claim 16, on

the other hand, recites "wherein the main unit is adapted to write a code of a function requested by the main unit in the write area." As such, claims 6, 11 and 16 recite and require that the main unit (e.g., Chew's reader) request a function code that is written in the register on the electronic device. This is completely opposite to what is disclosed in *Chew*.

The fact is that *Chew* simply does not include any disclosure suggestive of this aspect of the claims. Such is the case because *Chew* is replete with references that the reader unit, e.g., main unit, operates transparently to the memory card, e.g. electronic device. (See *Chew*, col. 5, lns. 38-41; col. 6, lns. 8-10; col. 9, lns. 41-43.) Thus, *Chew* explicitly teaches away from the claimed invention as there is no need for *Chew*'s reader unit to have any knowledge of the transactions occurring on the card.

Chew also clearly does not teach detection of a requested function by a main reader unit as asserted by the Examiner. In supporting this assertion the Examiner relies on column 4, lines 19-25 of *Chew*, which explicitly states: "The card has an input for receiving an external signal from outside the card to execute the one data element, and an operating system, which in response to the external signal coming from outside the card to execute one of the elements, commands an execution of the active data element, and thereby seamlessly also executes the added value function." In fact, as the quoted text makes clear, it's the memory cards operating system that detects the function and not the main reader unit. As such, applicant respectfully submits that the Examiner misconstrues the teachings of *Chew* in rejecting the claims. More particularly, in responding to applicant's arguments in the Amendment of August 4, 2003, the Examiner states that "*Chew* teaches the card is [in] communication with the terminal, and receives signals from the terminal (col. 4, lns. 19-25) to

select data elements and functions." However, as previously discussed, the claimed combination requires that the main unit detect and enable the functions residing on the memory card. This is completely opposite to what is taught by *Chew* and argued by the Examiner. In addition, *Chew* further makes it abundantly clear that the disclosed reading unit has no knowledge of the calculations being performed or the programs being executed by the memory card. (*Id.*) Therefore, there is no need in *Chew* for the reader card or main unit to ever detect the requested function.

Thus, for at least this reason, claims 6 and 11 are not obvious over *Chew* as these claims each recite "a read area in which the code of a function selected in the electronic device is read and detected by the main unit." *Chew* does not include any disclosure suggestive of this claim limitation.

Further in this regard, *Chew* unquestionably does not teach or suggest "controlling, by the main unit, execution of the requested function based upon at least the code of the function read from the read area" as is now recited in claim 1. As previously noted, this is the case because *Chew* is replete with explicit statements that "the added value function is a transparent transaction proceeding without knowledge of the reader." (*Id.*, col. 6, lns. 8-10.) Applicant therefore respectfully submits that for at least this reason *Chew* cannot be used to obviate claim 1.

Chew also does not teach or suggest "wherein the main unit is adapted . . . to control execution of the requested function in the electronic device based on the read code" as is recited in claim 16. *Chew* does not teach or suggest the reader unit, or main unit, controlling the memory card, or electronic device.

Simply put, *Chew* does not teach the combinations claimed in claims 1, 6, 11, and 16 as *Chew* is entirely focused

on and teaches that the functions of the main reader unit are to be "transparent" to the functions and operation of the memory card or electronic device. Applicant reminds the Examiner that the teachings of the reference as a whole as well as the invention as a whole must be considered in rejecting the claims. Manual of Patent Examining Procedure (MPEP) § 2141.02, at 2100-118 to 120 (8th ed. Aug. 2001). In addition, the references must teach or suggest all the claimed limitations. *Id.* § 2143.03, at 2100-26. Chew does not teach or suggest at least one of the claimed limitations, i.e., Chew's reader never detects or controls the electronic device nor does Chew's reader request a function resident on the memory device. It is only applicant's written description and claims that include this novel and nonobvious aspect of the claimed invention.

Further in this regard, Chew teaches that, according to the prior art, "the added value function was performed in the reader or remote processing system, and then the results of that added value function were stored in the card." (Chew, col. 5, lns. 5-10; col. 3, lns. 29-44.) In solving the prior art problems, Chew chooses to store the code and other functions necessary to perform a request in the memory card in addition to including an operating system in the memory card for executing such code. (*Id.*, col. 5, lns. 1-9; col. 5, lns. 6-25; col. 7, ln. 37; col. 8, ln. 65.) Thus, although column 6, lines 3-7 of Chew states that the "reader may or may not have knowledge of the association between the data element D and the value added function Fj, or the access function Gk" the remainder of Chew makes it abundantly clear that it's the memory card that controls the operations of the system, transparent to the main unit or reader.

In rejecting claims 18 and 19, the Examiner asserts that these claims are unpatentable over Chew as applied to claims 1-17, further in view of U.S. Patent No. 6,574,677 to

Song et al. (hereinafter "*Song*"). However, inasmuch as *Song* does not make up for any of the deficiencies in *Chew*, *Chew* and *Song* cannot be combined in any manner to obviate claims 18 and 19, or any claim presently pending in the application.

As the other pending claims depend from one of claims 1, 6, 11, or 16, applicant respectfully submits that the other pending claims are not obviated by *Chew* for the reasons discussed above. Furthermore, *Chew* and *Song* cannot be combined in any manner to obviate any of the claims presently pending in the application.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 8, 2004

Respectfully submitted,

By 

Orville R. Cockings

Registration No.: 42,424

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant